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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

WI 601702

Applicant(s)

Examiner

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☒ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 062403
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the claims contain a great number of informalities, translation related errors and the like and need to be significantly amended, if not entirely rewritten. The Examiner will point out a significant number of the errors, but others will be missed and applicant is urged to carefully correct whatever omissions in the claims the Examiner may have made. It is initially noted that many of the elements such as the "carrier element", "sealing body", "sealing element" and in some places "adhesive layer" or "adhesive cement" each lack proper antecedent basis for various elements which are referred to later in a particular claim or claims and should be corrected. Claim 6 is a de facto duplicate of claim 1, since the last line of claim 1 describes what is known in the art as a primer adhesive layer. In claim 3 "portions" is vague and

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indefinite and in claim 7 after "layer" in line 1 there should be a comma. In claims 8 and 22 the Examiner is unfamiliar with the term "enamel" as defining an adhesive layer or its equivalent. In claim 9, line 1, the last word "the" should be deleted and in lines 2-3 the phrase "another cement" is vague and indefinite. In claims 10 and 25 the usage of "cloth strip" as an adhesive layer is not believed to be proper, as cloth is not adhesive. In claim 11 "corona discharge" does not form "an adhesive layer" but rather a treated surface that has the property of being adhesive.

In claim 12, line 5, "attached" is believed more desirably stated as "coated". In claim 17 there is no antecedent basis in line 2 for the phrase "over the entire length of the sealing body" and in claim 18 the phrase "formed directly by" is not understood. In claim 19, the Examiner notes in passing that there appears to be no two sided adhesive carrier set forth, in line b) the phrase "to an adhesive layer" is not understood, and in claim 20, line d) the phrase "the adhesive layer, forming an adhesive surface," is improper grammar as is the phrase in line f) "at least one of temperature, pressure and moisture".

Additionally, the Examiner again notes that other errors may well have been missed or could be better stated by a suitable redrafting of the claim(s).

3. The following is a quotation of the first paragraph of

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35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 19-26 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for claims 1-18, does not reasonably provide enablement for the method inventions as set forth in claims 19-26. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. More particularly, applicant's method claims 19-26 are not set forth in the application except in the claims section, and accordingly the specification proper should be amended with a suitable amount of disclosure to provide express support for the claims, care being taken so that no new matter is introduced.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one

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year prior to the date of application for patent in the United States.

7. Claims 12, 13 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by DE 19952399A1, for which U.S. Patent 6,485,030 B1 to Hahn et al., an example of the inventor's earlier work, is relied upon for presenting a suitable translation thereof. Note particularly in the U.S. patent the Figure, the Abstract, column 1 lines 8-10, lines 43-45, line 61 - column 2 line 4, claims 1-7, and most particularly column 2 lines 16-50. The reference clearly discloses an elongated extruded selection of silicone adhered to carrier strip 14 on one outer surface, the carrier surface having on this particular surface a layer 18 of silicone cement over the entire length and width thereof. The carrier also has on an opposing opposite surface a self-sticking adhesive layer which may be protected by a suitable protective film 22, i.e. a release sheet, which is substantially all applicant's claims require.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 14-16, and 18-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE -399 as set forth in the Hahn et al. patent translation. The reference is again relied upon substantially as set forth above, as elements such as the primer layer set forth in the last line of claim 1 are believed to be well known in the sealing and adhesive art, as are such elements as cross-linking silicone compositions and the like and the use of corona discharge techniques. With respect to the method claims 19 and 20, these are each believed to be clearly nominal in form, reciting only those elements either disclosed by the reference or extremely well known process steps in the art that are strongly hinted at therein. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Kellos, Klammer, Zhang, and George et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

March 14, 2005

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zinker